




GOVERNMENT OF PUERTO RICO
DEPARTMENT OF STATE



March 25, 2023

Cristina Arenas Solis
221 Ponce de León Avenue Piso 5
San Juan, PR 00917

SUBJECT MATTER
MARK
CLASS
FILING NUMBER
FILING DATE
APPLICANT

Office Action

004
248840-04-0
July 25, 2022
Compañía Española de Petróleos, S.A.

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- x 1. State clearly the goods or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services.
2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico.
3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico.
4. Provide a specimen that shows the mark in connection with the goods or services identified in your application.
5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation.
6. Others.
1. The registration for the applied mark is refused on the following grounds:

OFFICE ACTION

The P.R. Trademark Office (the "PRTO") has reviewed its records and has determined that there are no similar or pending marks that would bar registration of this mark under the P.R. Trademark Act. However, in order to proceed with the examination of the mark, the PRTO requires the Applicant to amend the application as follows:

Description of Goods is Overly Broad:

Rule 20 of the Trademark Registry Procedure Code of the Department of State for The Commonwealth of Puerto Rico (hereinafter, the Rules) provides that applications for registration of trademarks must include a list of the goods or services in relation to which a Trademark registration is desired.

An application of a mark must specify the goods or services on or in connection with which the Applicant uses, the mark in commerce. The identification should set forth common names, using terminology that is generally understood. The identification of goods or services must be specific, definite, clear, accurate, and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), reversed on other grounds, 824 F.2d 957 (Fed. Cir. 1987); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), modified without opinion, 498 F.2d 1406 (C.C.P.A. 1974); *In re Cardinal Laboratories, Inc.*, 149 USPQ 709 (TTAB 1966); *California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc.*, 102 USPQ 321 (Comm'r Pats. 1954); *Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953).

The wording: "Industrial oils and greases; wax, namely, industrial wax, paraffin wax, waxes for use in the manufacture of other products; Lubricants, namely, industrial lubricants, motor vehicle lubricants, automotive lubricants, lubricants being gear oils; Dust absorbing, wetting and binding compositions; Fuels and illuminants, namely, fuel oils, motor gasoline, motor fuel, renewable fuels, illuminant fuels; Candles and wicks for lighting." under International Class 004, contains language that isn't specific enough therefore, resulting in a broad description of the products.

The Registry has discretion to require the degree of specificity necessary to identify the goods or services in relation to which the mark is used in the commerce of Puerto Rico.

The applicant may adopt the following recitation of goods, if accurate:

Class 04

"Industrial oils and greases; wax, namely, industrial wax, paraffin wax ; **oils**, waxes for use in the manufacture of other products; Lubricants, namely, industrial lubricants, motor vehicle lubricants, automotive lubricants ; lubricants being gear oils; Dust absorbing, wetting and binding compositions; Fuels and illuminants, namely, fuel oils, ~~motor gasoline~~, motor fuel, renewable fuels, illuminant fuels; **Fuel for motor vehicles, namely, gasoline**; Candles and wicks for lighting

* Note that these suggestions are illustrative and not exhaustive.

Applicant is advised to examine the International Classification of Goods and Services established under the Nice Agreement, Tenth Edition, to describe the products or services that are used commercially in Puerto Rico. See <http://www.wipo.int/classifications/nice/es/>.

Note that Rule 33 of the Rules provides that the applicant may amend his application during the review of the application, when required by the Examining Attorney or other official reasons. The applicant may amend his application to clarify or limit, but not to extend the identification of goods or services. Given the above, the Examining Attorney requires that the applicant modify and amend its application for renewal as indicated in this Office Action or otherwise show cause

why this amendment is not necessary.

In light of the aforementioned, the Examiner requires the Applicant to modify and/or amend the application for registration as provided herein or, otherwise, show cause why such modification is not required.

According to Rule 36 of Puerto Rico's Trademark Rules of Procedure amendments filed must be specified in a written and signed statement by the Applicant or its Representative. Neither Applicant nor its Representative shall rewrite, alter, modify, erase or include words in a pending application. However, the Puerto Rico Trademark Office (PRTTO) may amend the said application with the Applicant's consent.

According to Rule 27 of Puerto Rico's Trademark Rules of Procedure, if the PRTTO does not receive a response to the abovementioned remarks within ninety **(90) days**, the Application shall be considered abandoned.

Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/> using the transaction office action response. The cost for the said filing is **\$15.00**. If you have any questions via email to jpagan@estado.pr.gov

Cordially,



Julio J. Pagán Pérez
Examining Attorney
Puerto Rico Trademark Office